

REMARKS

In the Office Action, the examiner noted his prior restriction and election requirement, as well as Applicant's reply on March 11, 2005. Applicant made an election with traverse to prosecute claims 7, 9, 10, 13, 14, 24-29, and 34-50. The Examiner has withdrawn claim 37 from further consideration as being drawn to a non-elected species. Therefore, claims 7, 9, 10, 13, 14, 24-29, and 34-50 are pending and have been examined. Claim 37 has been withdrawn from consideration by the examiner; however, Applicant respectfully asserts that claim 37 depends from allowable, generic claim 34 and should be considered. Claims 13, 14, 24-29, and 34-36 and 38-50 have been rejected. Claims 34, 37 and 38 have been amended. With this amendment, reconsideration of claims 13, 14, 24-29, and 34-36 and 38-50, and favorable consideration of the withdrawn claim 37, is respectfully requested.

Examiner Robert has rejected claims 7, 10, 13, 14, 24, 28, 29, 34, 38-41, and 46-50 under 35 U.S.C. 102(e) as being allegedly anticipated by Dixon et al. (U.S. Patent No. 6,695,845). The present application is entitled to an effective filing date of October 25, 2000, as it is a divisional application (filed on August 5, 2003) claiming priority to Application Serial No. 09/696,128, filed on October 25, 2000 and issuing as U.S. Patent No. 6,605,090 on August 12, 2003. The '845 patent to Dixon was filed October 15, 2001 and claims priority to a provisional application filed October 16, 2000. Examiner Robert's rejection must rely on the Dixon provisional filing date.

Independent claims 24 and 34 both recite, among other things, the feature of an adhesive to secure the fastener (or bone screw) to the bone plate. Additionally, independent claim 40 recites the feature of the fastener being bonded to the bone plate. The examiner relies on claim 9 of the '845 patent to Dixon as evidence of anticipation of those features. However, claim 9 is not

supported by the Dixon provisional application, and it is not supported in the specification of the '845 patent to Dixon, as required by 35 U.S.C. § 112. On these two bases, the Dixon reference is not proper prior art, and Examiner Robert is respectfully requested to withdraw the rejections based on it.

Claim 9 of the '845 patent to Dixon recites screws being affixed to a plate and bone segments with adhesive-type bonding materials. However, there is no discussion in Dixon's provisional application of adhesive-type bonding materials. A copy of the Dixon provisional application taken from the PTO's on-line services is attached as Exhibit A for the examiner's reference, and he is respectfully requested to review the papers in the PTO's original files. The terms "adhesive" and "bonding" are not included in the provisional application, and no other disclosure in the provisional even suggests, much less supports, adhesives or bonding under the strictures of Section 112. Since those features are not disclosed in the manner required by Section 112, the Dixon '845 cannot be entitled to the provisional filing date for those features. MPEP 2136.03. To summarize, because the Dixon provisional application does not properly support (in compliance with 35 U.S.C. 112, first paragraph) the subject matter in the Dixon '845 patent relied upon to make the rejection, the '845 patent does not qualify as prior art under Section 102(e).

Moreover, Applicant notes that claim 9 of the '845 patent does not appear to be sufficiently disclosed under Section 112 to support the rejection of the claims of the present application. As noted above, the terms "adhesive" and "bonding" are not used in the '845 patent's specification, and "adhesive" is used only once in the claims, in claim 9. While it is acknowledged that in some cases claim language can be sufficient written description, it is respectfully submitted that this is not such a case. No types of adhesives are specified in the

Dixon reference, and no methods of placement or curing are discussed or suggested. The Dixon reference thus not only lacks sufficient written description of adhesives, but it also lacks any enabling disclosure of adhesives. Indeed, there is no “mode” of adhesive disclosed, much less a “best” mode. Accordingly, despite the presence of the word “adhesive” in its claim 9, the Dixon reference does not disclose the feature of “adhesive” or “bonding” as Section 112 requires. It cannot, therefore, anticipate the pending claims for that reason as well.

Accordingly, independent claims 24, 34 and 40 are not anticipated by Dixon. Dependent claims 7, 10, 13, 14, 28, 29, 38-39, 41 and 46-50 are also not anticipated by Dixon at least based on their dependency from independent claims 24, 34 and 40, and perhaps for other reasons. Therefore, Applicant respectfully requests that the ‘845 patent to Dixon be removed as a prior art reference and these rejections be withdrawn.

The examiner has rejected claims 9, 25-27, 35, 36, and 42-45 under 35 U.S.C. 103(a) as being unpatentable over the ‘845 patent to Dixon. Based on the foregoing, these dependent claims are patentable over Dixon due to their respective dependencies from independent claims 24, 34, and 40, among possibly other reasons.

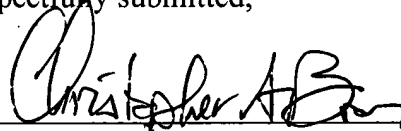
The examiner has rejected claims 34-39 under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 34 has been amended to address this rejection. No substantive or narrowing amendments have been made, and no new matter has been added. Therefore, Applicant respectfully requests that this rejection should now be withdrawn.

Applicants have not amended the substance of any claim, and do not intend to limit the scope of pending or later-offered claims. The claims are intended to have their full scope, including permissible equivalents and inclusion of all species, to which their language entitles them. Applicant respectfully submits the amendments and remarks in this paper have

been made in an effort to expedite prosecution of this case, and do not necessarily comprise all possible arguments in favor of patentability. Additionally, Applicant does not concede or admit that the '845 patent to Dixon or the provisional from which it claims priority adequately discloses other features of the claims of the present application, and further reserves the right to swear behind this reference at a later date.

In conclusion, reconsideration and allowance of this application is requested in view of the amendments and remarks made herein. Specifically, claims 7, 9, 10, 13, 14, 24-29, and 34-50 are in condition for allowance. If there are any outstanding issues, the examiner is invited to contact the undersigned attorney by telephone for their resolution.

Respectfully submitted,



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